

REMARKS/ARGUMENTS

Claims **1-46** were pending in this application. According to the August 7, 2007 Office Action, claims **1-46** were rejected.

We have amended independent claims **1, 25** and **36** and dependent claims **3, 8-10, 12, 26, 30, 33, 35, 37, 41, 43-44**, and **46**, and have added new dependent claims **47-72** to recite particular embodiments that we, in our business judgment, have currently determined to be commercially desirable. We have canceled dependent claims **2, 4-7, 11, 16-18, 21, 27-29, 31-32, 34, 38-40, 42**, and **45**. We will pursue the subject matter of the previously presented and canceled claims in one or more continuing applications. The amendments do not introduce any new matter.

Accordingly, the following claims are under consideration:

- Independent claims **1, 13, 25**, and **36**.
- Dependent claims **3, 8-10, 12, 14-15, 19-20, 22-24, 26, 30, 33, 35, 37, 41, 43-44**, and **46-72**.

1.0 Information Disclosure Statement

At page 2, the Examiner objected to the Information Disclosure Statement filed on January 20, 2004 because References O and P at page one of the PTO-1449 form and References Q, N, and O at page two of the PTO-1449 form were listed without publication dates. The publication dates of these references are unknown.

In response to the Examiner's objection, we are resubmitting herewith a PTO-1449 form re-listing the five references noted by the Examiner. The form now indicates that the publication dates for the references is "Unknown." In addition, the form also indicates, where applicable, the "date last visited."

No fee is believed to be due under 37 C.F.R. § 1.17(p) for this corrected PTO-1449 form because the five references were originally filed in compliance with 37 C.F.R. § 1.97(b)(3) before the mailing of a first Office Action on the merits.

Nonetheless, in the event that a fee is determined to be due, the Commissioner for Patents is hereby authorized to charge such fee to Deposit Account No. 50-3938.

2.0 Rejection of the claims under 35 U.S.C. § 112

At page 2, the Examiner rejected previously presented claims **9, 21, 32** and **43** under 35 U.S.C. § 112, second paragraph, as being indefinite because of the limitation, “*may not be established.*” The Examiner failed to establish a *prima facie* case of indefiniteness.

Specifically, under 35 U.S.C. § 112, second paragraph,

[t]he requirement to ‘distinctly’ claim means that the claim must have a meaning discernible to one of ordinary skill in the art when construed according to correct principles.... **Only when a claim remains insolubly ambiguous without a discernible meaning** after all reasonable attempts at construction must a court declare it indefinite.

(emphasis added); Metabolite Labs., Inc. v. Lab. Corp. of Am. Holdings, 370 F.3d 1354, 1366 (Fed. Cir. 2004); MPEP § 2173.02.

The Examiner failed to show that the claims are “insolubly ambiguous without a discernible meaning.” In fact, the record shows the opposite to be true in that the Examiner set forth several “interpretations” of the limitation. Accordingly, previously presented claims **9, 21, 32** and **43** are not “insolubly ambiguous without a discernible meaning” and the Examiner thereby failed to establish a *prima facie* case of indefiniteness with respect to these claims.

Nonetheless, we respectfully submit that the rejection is now moot in view of the amendments to claims **9** and **43**, and in that claims **21** and **32** have been canceled.

3.0 Rejection of the claims under 35 U.S.C. § 102(b)

At pages 2-4, previously presented claims **1-46** were rejected under 35 U.S.C. § 102(b) as being anticipated by Brenner et al., U.S. patent 5,830,068 (hereinafter Brenner).

3.1: Response to rejection of independent claim 13

Claim **13** (as originally presented) recites in part:

selecting a plurality of participants from the field of participants such that the odds associated with each of the selected participants combines to at least approximate the customized odds for the bet.

To establish a *prima facie* case of anticipation, the Examiner has the burden of showing how each and every element as set forth in a claim is found in the cited reference. In rejecting claim **13**, the Examiner asserted in part:

Therefore a gambler has the power to customize the odds for his/her bet by choosing between a quinella or exacta bet. Furthermore, when a gambler chooses to place an exacta or trifecta bet he or she is selecting a group of participants from a field of participants based on the odds of this prediction occurring and the first place choice is the lead participant.

(Office Action, paragraph 2, pages 3-4).

Notably, in the rejection, the Examiner made no reference to the limitation, “*selecting a plurality of participants ... such that the odds associated with each of the selected participants combines to at least approximate the customized odds for the bet,*” as claim **13** recites, and as such, the Examiner failed to show how and or where such limitations are disclosed by Brenner.

Accordingly, the Examiner failed to establish a *prima facie* case of anticipation of claim **13**. Because claims **14-15**, **19-20**, and **22-24** depend from claim **13**, the Examiner failed to establish a *prima facie* case of anticipation of these claims for at least the same reasons as claim **13**.

3.2: Response to rejection of dependent claim 22

Claim **22** (as originally presented) recites:

determining a target percentage based at least in part upon the customized odds for the bet and a takeout associated with the bet, and wherein selecting a plurality of participants from the field of participants further comprises selecting a plurality of participants based at least in part upon the target percentage.

In rejecting claim **22**, the Examiner asserted in part:

[T]he reference to Brenner inherently incorporates sports betting at a race track and horse racing. Therefore, the features based on the odds associated with a participant in a race are also inherently incorporated. In other words, the limitation about ... target percentage are typical features of sports betting at a race track. As shown by Rossides (US 6,443,841 B1), which is cited in this action as extrinsic evidence. The Rossides reference defines one to one odds as a percentage of 50% ... and defines the equation ... used to calculate a target percentage or payoff odds as a percentage. Therefore a gamblers total returns or payoff is based on the odds.

(Office Action, paragraph 3, page 4).

First, we note that in the rejection, the Examiner made no reference to the limitation, “*wherein selecting a plurality of participants from the field of participants further comprises selecting a plurality of participants based at least in part upon the target percentage,*” as claim **22** recites, and as such, the Examiner failed to show how and or where such limitations are disclosed by Brenner. Accordingly, the Examiner failed to establish a *prima facie* case of anticipation of claim **22**.

Second, regarding the Examiner’s apparent assertion that “Brenner inherently incorporates” the features of claim **22**, it is unclear what the Examiner means for a reference to inherently incorporate features. We draw the Examiner’s attention to MPEP § 2112, which states in part:

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.... ‘In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.’

MPEP § 2112 (IV) (internal quotes omitted).

Assuming, *arguendo*, that the Examiner may have been rejecting claim **22** based on inherency, we note that the Examiner failed to comply with MPEP § 2112 in that the Examiner failed to provide a basis in fact and/or technical reasoning to support a determination that the limitations of claim **22** necessarily flow from the teachings of Brenner. As such, any apparent rejection based on inherency is inadequate.

Third, regarding the Examiner’s reference to Rossides, assuming, *arguendo*, that the Examiner may have been asserting that the limitations of claim **22** are disclosed by a combination of Brenner and Rossides, the Examiner’s rejection of claim **22** under 35 U.S.C. § 102 is improper. Specifically, a claim is anticipated only if each and every element as set forth in the claim is found in a single prior art reference. Accordingly, any rejection based on a combination of Brenner and Rossides is improper under 35 U.S.C. § 102. If the Examiner wishes to maintain a rejection of claim **22** based on a combination of Brenner and Rossides, we respectfully request that the Examiner properly raise the rejection under 35 U.S.C. § 103.

3.3: Response to rejection of dependent claim 20

Claim **20** (as originally presented) recites:

allocating a portion of the bet amount to each of the selected participants, wherein the allocation is based at least in part upon the odds associated with each of the selected participants.

In rejecting claim **20**, the Examiner asserted:

[T]he prior art discloses a type of bet quinella that is also called an exacta box. The Examiner would like to state again that information associated with sports betting on horse races is inherent and incorporated by the reference. A quinella bet is made by placing different or similar amount of cash on each of the gambler's two choices therefore a portion of the total bet amount is allocated to each participant. The gambler makes this decision, which is based on any number of factors, and the odds associated with each participant is a possible factor.

(Office Action, paragraph 4, page 4).

Notably, in rejecting claim **20** the Examiner failed to make any reference to Brenner and as such, failed to show how and or where the limitations of claim **20** are disclosed by Brenner. Rather, the Examiner made conclusory assertions (e.g., "The gambler makes this decision, which is based on any number of factors, and the odds associated with each participant is a possible factor.") unsupported by any factual findings. Such assertions, unsupported by any factual findings, are insufficient to establish a *prima facie* case of anticipation.

Regarding the Examiner's assertion that information is "inherent and incorporated by the reference," assuming, *arguendo*, that the Examiner may have been rejecting claim **20** based on inherency, we again note that the Examiner failed to comply with MPEP § 2112 in that the Examiner failed to provide a basis in fact and/or technical reasoning to support a determination that the limitations of claim **20** necessarily flow from the teachings of Brenner. As such, any apparent rejection based on inherency is inadequate.

3.4: Response to rejection of independent claims 1, 25, and 36

Amended independent claim **1**, and similarly amended independent claims **25** and **36**, recite in part:

determine that a combination of at least the first odds and the second odds at least approximates the desired odds.

As similarly discussed above, Brenner has not been shown to disclose such limitations.

Regarding dependent claims **3, 8-10, 12, 26, 30, 33, 35, 37, 41, 43-44, and 46,** because these claims depend from independent claims **1, 25, and 36,** Brenner has not been shown to disclose all limitations of these claims for at least the same reasons as claims **1, 25, and 36.**

4.0 New dependent claims 47-72

Dependent claims **47-72** depend from independent claims **1, 25, and 36** and as such, Brenner has not been shown to disclose all limitations of these claims for at least the same reasons as claims **1, 25, and 36**

5.0 Conclusion

In view of the amendments and remarks, we respectfully submit that the claims are in condition for allowance. We request that the application be passed to issue in due course. The Examiner is urged to telephone our undersigned representative at the number noted below if it will advance the prosecution of this application, or with any suggestion to resolve any condition that would impede allowance.

Respectfully submitted,

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Date

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